Hovsepian v. Apple, Inc.

EXHIBIT B

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION, Plaintiff, vs. NEW DESTINY INTERNET GROUP, et. al., Defendants.	Case No. SACV 02-1040 JW (MLGx) **Consolidated Cases:** SA CV 02-1048-JW (MLGx) SA CV 02-1063-JW (MLGx) SA CV 02-1155-JW (MLGx) SA CV 03-0217-JW (MLGx) SA CV 03-0218-JW (MLGx) SA CV 03-0219-JW (MLGx) SA CV 03-0259-JW (MLGx) SA CV 03-0271-JW (MLGx) SA CV 03-0308-JW (MLGx) **Related Cases:** SA CV 03-1610-JW (MLGX) SA CV 03-1800-JW (MLGX) SA CV 03-1801-JW (MLGX) SA CV 03-1803-JW (MLGX) SA CV 03-1804-JW (MLGX) SA CV 03-1805-JW (MLGX) SA CV 03-1807-JW (MLGX) **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S CLAIM CONSTRUCTION BRIEF RE: CLAIM TERMS IN THE '702 PATENT** **DATE: May 19, 2004** **TIME: 9:00 a.m.** **CTRM: Hon. James Ware**
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I. INTRODUCTION

This brief addresses Acacia's proposed construction of the following seven claim phrases of U.S. Patent No. 6,144,702 (the '702 patent) (Exhibit 1 to Block Decl.) and one claim phrase of U.S. Patent No. 5,132,992 (the '992 patent) (Exhibit 2 to Block Decl.):

1. "a transmission system at a first location in data communication with a reception system at a second location";
2. "sequence encoder";
3. "identification encoder";
4. "transceiver";
5. "wherein said identification encoder allows entry of a popularity code";
6. "temporary storage device";
7. "digital compressor" (Claim 1 of the '702 patent), which was changed to "digital decompressor" by certificate of correction; and
8. "ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks" ('992 patent -- Claim 1).

II. BACKGROUND TO ACACIA'S U.S. PATENT NO. 6,144,702

Acacia's U.S. Patent No. 6,144,702 (the '702 patent) is a continuation patent, which claims priority from Acacia's U.S. Patent No. 5,132,992 (the '992 patent). This means that the '702 patent has essentially the same specification and figures as the '992 patent and has the same effective filing date as the '992 patent -- January 7, 1991. The only difference between the '702 patent and the '992 patent are the claims.

A. The Claims Of The '702 Patent Relate To A Communication System Which Comprises Both A Transmission System And A Reception System

The '702 patent has 42 claims, three of which are independent claims -- 1, 17, and 27. Each of the claims of the '702 patent claims a "communication system," which comprises both a transmission system and a reception system. The transmission system is at a first location and the reception system is at a second location. The claims further define the elements contained in the transmission system and in the reception system.

Representative claim 1 of the '702 patent is reproduced below:

1. A communication system comprising:
a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises:
a sequence encoder,
an identification encoder, and
a compressed data library in data communication with said identification encoder,
wherein said identification encoder gives items in said compressed data library a unique identification code; and
wherein said reception system comprises:
a transceiver in data communication with said transmission system,
a storage device in data communication with said transceiver,
user playback controls in data communication with said storage device,
a digital decompressor in data communication with said storage device, and
a playback device in data communication with said digital decompressor.

Claims 17 and 27 of the '702 patent are similar to claim 1 of the '702 patent in that they also claim a communication system comprising both a transmission and a reception system, however, claim 17 adds a number of elements not present in claim 1 and claim 27 excludes the "sequence encoder" limitation, but includes the requirement that the identification encoder be capable of allowing entry of a popularity code.

Unlike claim 1 of the '992 patent, none of the claims of the '702 patent use the term "means for." There is thus no presumption that the phrases of the '702 patent are to be construed as "means-plus-function" phrases pursuant to § 112, ¶ 6. None of the parties have offered in their discovery responses any construction of any term or phrase of the '702 patent as a "means-plus-function" or "step-plus-function" phrase under § 112, ¶ 6. Thus, all of the claim terms of the '702 patent are construed using the claim construction rules for conventional claim terms.

B. Description Of System Elements Of The Claims of the '702 Patent

Claim 1 of the '702 patent is a system claim; it lists a number of elements contained in the transmission system and a number of elements contained in the reception system. The transmission system and the reception system together comprise the claimed "communication system." The claims state that the transmission system is at a first location and the reception system is at a second location. This simply means that the transmission and reception systems are at different locations from each other.

As claim 1 is a system claim, it does not include the user or a user request -- it is merely a list of the elements to be included in the transmission and reception systems. Claim 1 also states that some of the elements are in "data communication" with each other. This means that information is capable of being moved between the various elements using any communication technique.

For claim 1 of the '702 patent, Acacia will provide a short description of each element in a particular embodiment of the transmission system and the reception system. This description of this embodiment does not limit the scope of the claims, which may be broader. This description is provided for illustrative purposes only.

1. The Transmission System

The transmission system is shown generally in Figures 1a-1g, 2a, and 2b of the '702 patent. The '702 patent specification states that the transmission system may be located in one or more facilities and that the transmission system may include only some of the elements shown in Figures 1a-1g, 2a, and 2b:

> FIGS. 2a and 2b illustrate detailed block diagrams of preferred implementations of the transmission system 100 of the present invention. Transmission system 100 may either be located in

> one facility or may be spread over a plurality of facilities. A preferred embodiment of transmission system 100 may preferably include only some of the elements shown in FIGS. 2a and 2b.

('702 patent, 5:56-62).

Further, the specification makes clear that the system includes system operators:

> The storage encoding process may be run by the system operator whereby the system operator accesses the master item database to track and describe items stored in one or more compressed data libraries.

('702 patent, 10:59-63; see also, 8:29-32; 10:36-39; and 14:13-26).

a) The Sequence Encoder

Although the phrase "sequence encoder" is not explicitly used in the specification of the '702 patent, the claims and the specification of the '702 patent make clear that the "sequencer encoder" refers to the time encoder which places data blocks into a sequence of addressable data blocks prior to subsequent compression:

> As shown in FIG. 2a, the ordering means in the preferred embodiment includes time encoder 114. After the retrieved information is converted and formatted by the converter 113, the information may be time encoded by the time encoder 114.
>
> * * *
>
> The sequence of addressable data blocks which was time encoded and output by time encoder 114 is preferably sent to precompression processor 115.

('702 patent, 7:52-57; 8:46-49).

The specification of the '702 patent further describes the benefits of time encoding prior to subsequent compression to the overall operation of the transmission and reception systems, because, among other things: (1) time encoding allows users to move through data in various modes by moving through frame addresses at various rates ('702 patent, 8:22-24); (2) time encoding makes items and subsets of items retrievable and addressable throughout the transmission system ('702 patent, 8:37-39); (3) time encoding makes possible realignment of audio and video data after separate audio and video compression ('992 patent, 7:60-64 and 8:9-10); and (4) time encoding enables subsequent compression of the information to be improved, because data reduction processes may be performed in the time dimension. ('702 patent, 8:39-43).

b) The Identification Encoder

The identification encoder is described in the specification of the '702 patent as an encoder which gives items a unique identification code and which optionally logs details about the item and assigns the item a popularity code. ('702 patent, 6:31-42). According to claim 1 of the '702 patent, the identification encoder gives items in the compressed data library a unique identification code. According to claim 27 of the '702 patent, the identification encoder allows entry of a popularity code.

c) Popularity Code

The popularity code represents the popularity of a particular item. It may be assigned on the basis of how often the particular item is expected to be requested for transmission and it may be updated to take into account how often an item is actually transmitted. ('702 patent, 12:5-7; 12:13-14). The identification encoder may be used to enter a popularity code for an item in the transmission system. ('702 patent, 6:35-38; 12:4-5).

d) The Compressed Data Library

The compressed data library is a library (place or collection) in which files containing the processed data for the audio and/or video information are stored before being made available to one or more reception systems. The compressed data library is, for example, described as being a mass storage device:

> The compressed data storage means preferably includes compressed data library 118, as shown in FIG. 2b. After the data is processed into a file by the compressed data storage means 117, it is preferably stored in a compressed data library 118. In a preferred embodiment, compressed data library 118 is a network of mass storage devices connected together via a high speed network. Access to any of the files stored in compressed data library 118 is available from multiple reception systems 200 connected to the transmission and receiving system.

('702 patent, 10:15-24).

2. The Reception System

The reception system is shown in Figures 1a-1g and 6 of the '702 patent.

a) The Transceiver

The transceiver is a device capable of both transmitting and receiving data. In the reception system, the transceiver is described and shown as receiving the information that was transmitted by the transmission system to the reception system: "[t]he transceiver 201 automatically receives the information from the transmitter 122 as compressed formatted data blocks." ('702 patent, 17:25-27; Figure 6).

b) The Storage Device

The storage device is used to store the information received by the reception system prior to play back by the user. The storage device may either store all of the item received by the reception system for later viewing by the user, or it may store just a portion of the item, while the system decompresses other portions of the item for immediate viewing, as it is being distributed by the transmission system:

> The reception systems 200 may either buffer[1] the requested material for later viewing, or decompress in real time the

[1] The term "buffer" is another way of saying that data is temporarily stored. (See, IEEE Dictionary, infra, 5th Ed. at 135; Exhibit 11 to Block Decl.)

> requested material as it is distributed by transmission system 100. Alternatively, the reception systems 200 of the present invention may perform a combination of buffering and non-buffering by buffering some of the requested material and decompressing the remainder of the requested material for immediate viewing as it is distributed by transmission system 100.
>
> * * *
>
> Storage 203 allows for temporary storage of the requested item until playback is requested.

('702 patent, 4:66 - 5:7 and 17:38-39; Figure 6).

c) The User Playback Controls

The user playback controls are controls in the reception system which allow the user to control the presentation of the received item:

> The reception system 200 has playback controls similar to the controls available on a standard audio/video recorder. These include: play, fast forward, rewind, stop, pause, and play slow.

('702 patent, 16:55-58).

d) The Digital Decompressor

The items received by the reception system are compressed. Accordingly, they will need to be decompressed prior to playback in the decompressor. ('702 patent, 17:44-46; Figure 6).

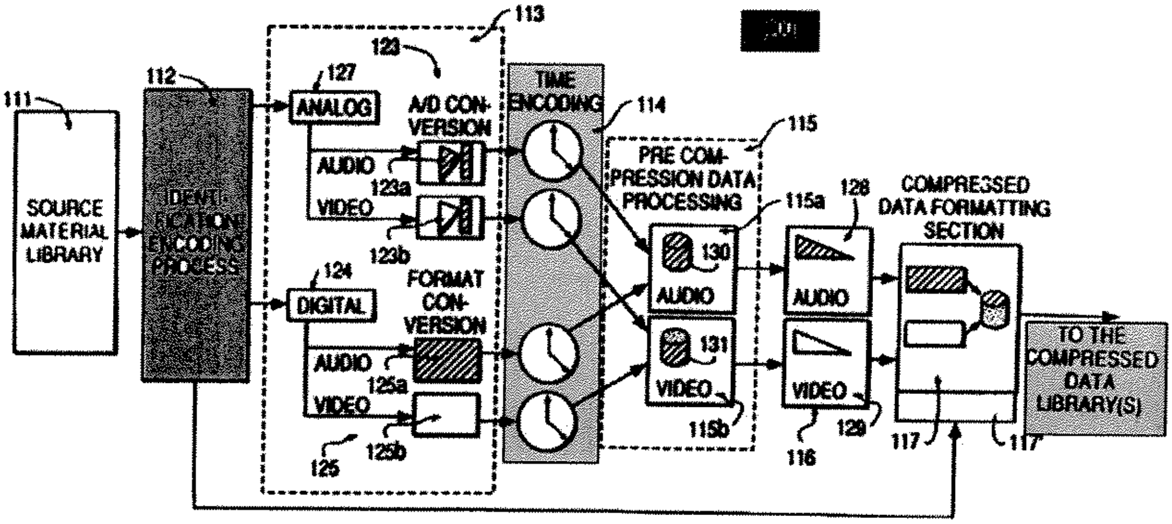
e) The Playback Device

The playback device is the device on which the user will view or listen to the received item, such as a television or audio amplifier. ('702 patent, 17:53-54).

3. Description Of System Elements From The Figures And A Representative Claim Of The '702 Patent

The systems and methods described above are reinforced by Figures 2a, 2b, and 6 of the '702 patent, which Acacia has reproduced below. For the convenience of the Court, Acacia has color-coded Figures 2a, 2b, and 6 and the elements of representative claim 1 of the '702 patent to show the correspondence between the elements of the claim and these Figures.

Figure 2a Of The '702 Patent



SOURCE MATERIAL LIBRARY
IDENTIFICATION ENCODING PROCESS
ANALOG
A/D CONVERSION
AUDIO
VIDEO
DIGITAL
FORMAT CONVERSION
TIME ENCODING
PRE COMPRESSION DATA PROCESSING
AUDIO
VIDEO
COMPRESSED DATA FORMATTING SECTION
TO THE COMPRESSED DATA LIBRARY(S)
111
112
113
114
115
115a
115b
116
117
123
123a
123b
124
125
125a
125b
127
128
129
130
131

FIG. 2a

Figure 2b Of The '702 Patent

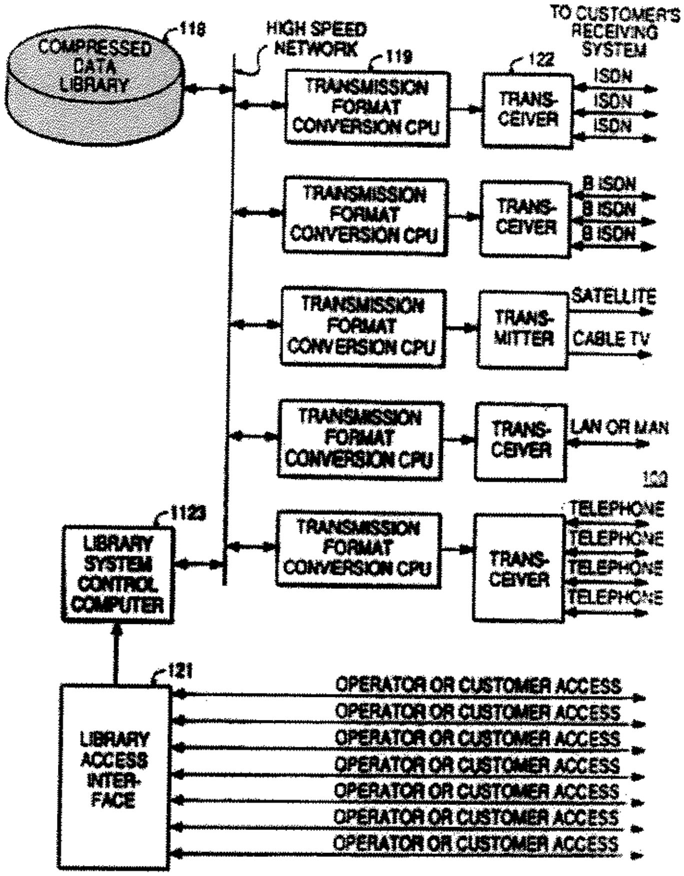

COMPRESSED DATA LIBRARY
118
HIGH SPEED NETWORK
119
TO CUSTOMER'S RECEIVING SYSTEM
122
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
ISDN
ISDN
ISDN
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
B ISDN
B ISDN
B ISDN
TRANSMISSION FORMAT CONVERSION CPU
TRANS-MITTER
SATELLITE
CABLE TV
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
LAN OR MAN
100
1123
LIBRARY SYSTEM CONTROL COMPUTER
TRANSMISSION FORMAT CONVERSION CPU
TRANS-CEIVER
TELEPHONE
TELEPHONE
TELEPHONE
TELEPHONE
121
LIBRARY ACCESS INTER-FACE
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS
OPERATOR OR CUSTOMER ACCESS

FIG. 2b

Figure 6 Of The '702 Patent

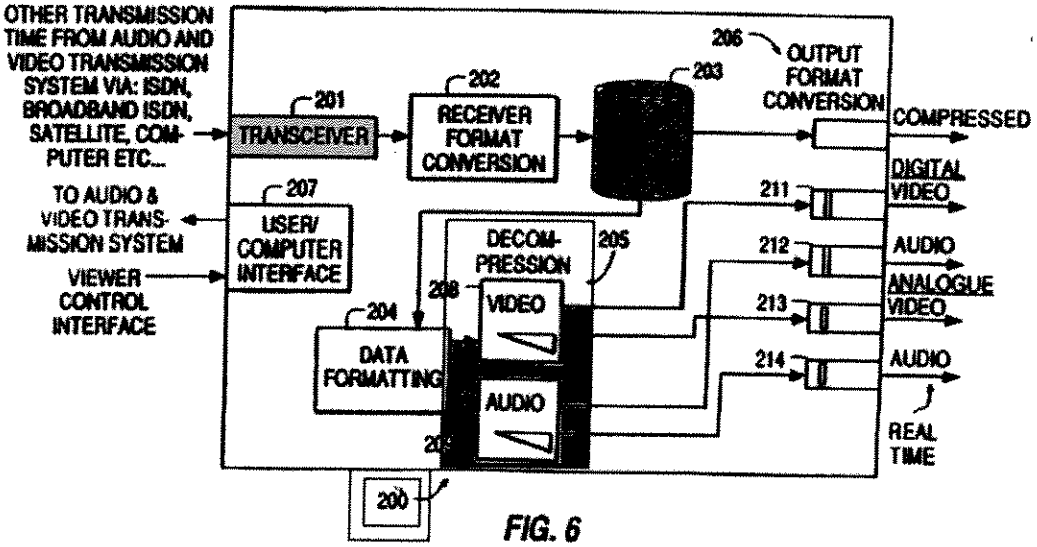

OTHER TRANSMISSION TIME FROM AUDIO AND VIDEO TRANSMISSION SYSTEM VIA: ISDN, BROADBAND ISDN, SATELLITE, COM-PUTER ETC...
201
TRANSCEIVER
202
RECEIVER FORMAT CONVERSION
203
206
OUTPUT FORMAT CONVERSION
COMPRESSED
DIGITAL VIDEO
211
TO AUDIO & VIDEO TRANS-MISSION SYSTEM
207
USER/ COMPUTER INTERFACE
DECOM-PRESSION
205
212
AUDIO
VIEWER CONTROL INTERFACE
208
VIDEO
213
ANALOGUE VIDEO
204
DATA FORMATTING
214
AUDIO
AUDIO
REAL TIME
200

FIG. 6

Claim 1 Of The '702 Patent

1. A communication system comprising:

a [redacted] at a first location in data communication with a reception system at a second location, wherein said [redacted] comprises:

a [redacted],

an identification encoder, and

a compressed data library in data communication with said identification encoder

wherein said identification encoder gives items in said compressed data library a unique identification code; and

wherein said reception system comprises:

a transceiver in data communication with said [redacted],

a storage device in data communication with said transceiver,

user playback controls in data communication with said storage device,

a digital decompressor in data communication with said storage device, and

a playback device in data communication with said digital decompressor.

C. The Prosecution History Of The '702 Patent

In construing the claims of the '702 patent, the Court must consult the prosecution history of the '702 patent.

The inventors filed the application for the '702 patent on July 23, 1998, claiming priority from a string of continuation applications back to the application which resulted in the '992 patent. No changes were made to the specification of the

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'992 patent, other than to add a paragraph at the beginning of Column 1 showing the lineage of the application, and thereby showing priority to the '992 patent filing date of January 7, 1991.

On February 10, 1999, the inventors filed a preliminary amendment, which canceled the original claims of the prior application and added claims 33-59 for examination by the Patent Office. (Exhibit 3 to Block Decl.)

On June 22, 1999, the Patent Office issued a first substantive Office action regarding its examination of pending claims 33-59. (Exhibit 4 to Block Decl.) In the Office Action, the examiner rejected claims 33-37 and 41-49 as being anticipated by a prior art patent to Tindell, U.S. Patent No. 5,130,792. The examiner indicated that claims 38, 39, 40, and 50-59 would be allowable if the inventors made certain technical changes to the claims to overcome a double patenting rejection.

On August 6, 1999, in response to the Office Action, the inventors amended claim 33 to add the limitation that the identification encoder gives items in the compressed data library a unique identification code. (Exhibit 5 to Block Decl.) The inventors also added claims 60-75 (which ultimately became claims 27-42 of the '702 patent).

On October 22, 1999, the examiner rejected claims 33-75 of the application over a patent to DeBye, U.S. Patent No. 5,701,582. (Exhibit 6 to Block Decl.) On November 12, 1999, in response, the inventors made a showing that the DeBye reference was not prior art. (Exhibit 7 to Block Decl.) On January 19, 2000, the patent examiner issued another rejection of claims 33-37 and 41-49 over Walter, U.S. Patent No. 4,506,387. (Exhibit 8 to Block Decl.) The examiner allowed claims 38-40 and 50-75.

On March 23, 2000, the inventors amended claim 33 (which became claim 1 of the '702 patent) to include the limitation of claim 39. (Exhibit 9 to Block Decl.) Claim 39 added the limitation to claim 33 that the transmission system included a sequence encoder. On June 1, 2000, the examiner issued a Notice of Allowance of claims 33-38, 40-46, 48, 47, 49-72, 74, 73, and 75, which were renumbered to 1-42 for issuance in the '702 patent. Claim 33, with the "sequence encoder" limitation, became claim 1 of the '702 patent. (Exhibit 10 to Block Decl.)

The '702 patent issued on November 7, 2000.

On April 15, 2003, the Patent Office issued a Certificate of Correction correcting the Patent Office's typographical error in Claim 1, which erroneously included "digital compressor," instead of "digital decompressor." (Exhibit 20 to Block Decl.)

III. PRINCIPLES OF CLAIM CONSTRUCTION

In its brief regarding the construction of the terms of the '992 patent, Acacia addressed the Federal Circuit law for construing patent claims. Because the Court is already familiar with the Federal Circuit law for construing patent claims, Acacia will not reproduce the legal section here, but instead shall hereby incorporate by reference the Principles of Claim Construction from its prior claim construction brief on the terms of the '992 patent.

IV. ACACIA'S CONSTRUCTION OF THE EIGHT CLAIM PHRASES AT ISSUE

D. "A Transmission System At A First Location In Data Communication With A Reception System At A Second Location"

This phrase is found in independent claims 1, 17, and 27 of the '702 patent and is comprised of the phrases "transmission system;" "reception system;" "first location;" "second location;" and "data communication." Acacia will address each of these phrases separately.

1. "Transmission System"

As with all claim terms, there is a heavy presumption that the term carries its ordinary meaning. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002). The Court must begin with the claim itself and determine the ordinary and customary meaning of the phrase "transmission system." Arlington Industries, Inc. v.

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Bridgeport Fittings, Inc. v. Bridgeport Fittings, Inc., 345 F.3d 1318, 1325 (Fed. Cir. 2003).

In determining the ordinary meaning of a claim term, the Court may consult dictionaries, encyclopedias, and scientific treatises which were publicly available at the time that the patent issued. Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed. Cir. 2002) ("When a patent is granted, prosecution is concluded, the intrinsic record is fixed, and the public is placed on notice of its allowed claims. Dictionaries, encyclopedias and treatises, publicly available at the time the patent issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art.") The dictionary definition cannot, however, contradict any definition found in or ascertained by a reading of the patent documents and must be consistent with the words used by the inventors. CCS Fitness, 288 F.3d at 1366; Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n 6 (Fed. Cir. 1996); Texas Digital, 308 F.3d at 1204; Renishaw PLC v. Marposs Societa' per Anzioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998) ("[a] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty").

Where the claim term has multiple dictionary definitions, the Court must identify which of the possible dictionary definitions is most consistent with the use by the inventor; if more than one definition is consistent, then the Court shall construe the claim term to encompass all such consistent meanings. Texas Digital, 308 F.3d at 1203 ("Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor. If more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all such consistent meanings."); Rexnord

Corp. v. Laitram Corp., 274 F.3d 1336, 1343 (Fed. Cir. 2001) (where claim term had two dictionary definitions, district court erred by finding claim term to be indefinite and therefore not giving the term the full range of its meanings, which would encompass both definitions.)

Looking first to the ordinary meaning, the phrase "transmission system" is specifically defined in the IEEE Standard Dictionary of Electrical and Electronic Terms, Fifth Edition, 1993, at p. 1405 (hereinafter "IEEE Dictionary"; Exhibit 11 to Block Decl.): "In communication practice, an assembly of elements capable of functioning together to transmit signal waves."

The IEEE Dictionary gives further definition to the term "system": "A collection of people, machines, and methods organized to accomplish a set of specific functions." (IEEE Dictionary, at 1329).

Looking next to the '702 patent specification, these definitions for the phrase "transmission system" and the term "system" are consistent with and reinforced by their use by the inventors in the '702 patent. The transmission system is shown generally in Figures 1a-1g, 2a, and 2b of the '702 patent.[2] As shown in the Figures and described in the specification, the transmission system comprises a number of elements (machines and methods), which function together to accomplish the purpose of transmitting formatted information. The specification also states that the transmission system includes system operators. ('702 patent, 8:29-32; 10:36-39; 10:59-63; and 14:13-26).

Therefore, the definition of "transmission system," which uses the term "elements" should be further defined by the definition of "system," which elaborates on the meaning of "elements" to include "people, machines, and methods." This

[2] The transmission system is not limited to all of the elements shown in Figures 2a and 2b. The '702 patent specification states that the transmission system may include only some of the elements shown in Figures 2a and 2b. ('702 patent, 5:60-62).

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definition is consistent with the use of these terms by the inventors and is therefore a correct construction for "transmission system."

The patent specification gives additional information which further defines the "transmission system." This information is not included in the dictionary definitions, but should be included in the Court's construction. For instance, the dictionary definition of "transmission system" is unclear as to where the elements of the system may be located. The '702 patent specification clarifies the inventors' intent -- the specification states that the transmission system may either be located in one facility or may be spread over a plurality of facilities. ('702 patent, 5:58-60).

Thus, the phrase "transmission system" is construed as:

> "an assembly of elements, such as people, machines, and/or methods, capable of functioning together to transmit signals. The transmission system may be located in one facility or may be spread over a plurality of facilities."

2. "Reception System"

Looking first to the ordinary meaning of the phrase "reception system," the term "reception" means: "the act of receiving." (Webster's Ninth New Collegiate Dictionary, Merriam-Webster, Inc., at 982 (1983); Exhibit 12 to Block Decl.) Thus, by analogy to the meaning of transmission system (transmitting signals), a reception system receives signals. The term "system" is defined as: "A collection of people, machines, and methods organized to accomplish a set of specific functions." (IEEE Dictionary, at 1329; Exhibit 11 to Block Decl.)

Looking next at the '702 patent specification, these ordinary meanings are consistent with and reinforced by the specification of the '702 patent. The reception system is shown in Figures 1a-1g and 6 of the '702 patent, which show the elements which, in one embodiment, comprise the reception system.

Thus, the phrase "reception system" is construed as:

"an assembly of elements, such as people, machines, and/or methods, capable of functioning together to receive signals."

3. "First Location" And "Second Location"

The claim phrase states that the transmission system is at a first location and that the reception system is at a second location. This means that the transmission system and reception systems are at different locations. This is the definition offered by defendants in their initial discovery responses (Exhibit 13 to Block Decl. at 124).

The relationship of the transmission system to the reception system is shown in Figures 1a-1g of the '702 patent. In each figure, the transmission system is shown at a location where there reception system is not and the reception systems is shown at a location where the transmission system is not. The specification states that the transmission system sends the file to "at least one remote location," i.e., to at least one reception system. ('702 patent, 15:19-23).

Thus, the terms "first location" and "second location" are construed to mean that the transmission system and the reception system are at different locations.

4. "Data Communication"

The claim states that a transmission system is in data communication with a reception system.[3] Other claim elements use the phrase "data communication," in, for instance, claim 1 of the '702 patent: the compressed data library is in data communication with the identification encoder; the transceiver of the reception system is in data communication with the transmission system; the storage device is

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[3] The fact that the claim says that a transmission system is in data communication with a reception system does not mean that this claim is limited to communication systems which have only one transmission system and one reception system. The claim uses the term "comprising," which is an open-ended term meaning that the claimed communication includes a transmission system and a reception system and may include additional elements as well. Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501 (Fed. Cir. 1997) ("'Comprising' is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.") Further, the specification discloses many embodiments of communication systems in which more than one transmission system and/or more than one reception system. (See, e.g., '702 patent, Figures 1b, 1c, 1e, 1f, and 1g and 3:63 - 4:12; 4:20-61).

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in data communication with the transceiver; the user playback controls are in data communication with the storage device; the digital decompressor is in data communication with the storage device; and the playback device is in data communication with the digital compressor.

The IEEE Dictionary defines "data communication" as: "[t]he movement of encoded information by means of communications techniques." (IEEE Dictionary, at 305; Exhibit 11 to Block Decl.)

The ordinary meaning is consistent with and reinforced by the specification. The patent specification shows and describes the movement of information through the transmission and reception system. The compressed data library being in data communication with the identification encoder is shown in Figure 2a and described at 6:39-47. The transceiver of the reception system being in data communication with the transmission system is shown in Figures 1a-1g, 2b, and 6 and described at 15:61-16:15; 16:45-17:24; and 18:3-8. The storage device being in data communication with the transceiver is shown in Figure 6 and described at 18:9-21. The user playback controls being in data communication with the storage device is described at 17:35-43. The digital decompressor being in data communication with the storage device is shown in Figure 6 and described at 18:27-35. The playback device being in data communication with the digital compressor is shown in Figure 6 and described at 18:36-45. In each example, there is the movement of information between these elements.

Thus, the phrase "data communication" is construed to mean "the movement of encoded information by means of communications techniques."

E. "Sequence Encoder"

The phrase "sequence encoder" is found in claims 1, 7, 17, and 18.

The term "encoder" has a well-known meaning to those of skill in the art of electrical engineering, electronics, and computing. An encoder is "a device or system that encodes data." (IEEE Dictionary, at 437; Exhibit 11 to Block Decl.) An encoder "may be implemented in hardware or software." (Dictionary of Computing, 3rd Ed. 1990, at 155; Exhibit 14 to Block Decl.) The term "encode" is also well-known and means: "(1) to express a single character or a message in terms of a code; (2) to produce a unique combination of a group of output signals in response to each of a group of input signals; (3) to apply the rules of a code; and (4) to represent data in symbolic form using a code or a coded character set such that reconversion to the original form is possible." (IEEE Dictionary, at 436-437; Exhibit 11 to Block Decl.)[4]

The term "encoder" is further defined and narrowed by the term "sequence," which means "a continuous or connected series." (Webster's, at 1073; Exhibit 12 to Block Decl.) See also, Personalized Media Communications, LLC v. International Trade Commission, 161 F.3d 696, 705 (Fed. Cir. 1998) (a qualification placed upon a structure narrows the scope of the structures covered by the claim: "The use of the word 'digital' in conjunction with the word 'detector' merely places an additional functional constraint (extraction of digital information) on a structure (detector) otherwise adequately defined."). Thus, the type of encoder disclosed in the claim is an encoder which creates a sequence. The definition of encode which is most consistent with creating a sequence is "to produce a unique combination of a group of output signals in response to each of a group of input signals."[5]

The ordinary meaning of sequence encoder is therefore a device or software capable of producing a unique combination of a group of output signals in response to each of a group of input signals.

[4] The term "sequencer" is another way of expressing the phrase "sequence encoder." The term "sequencer" means "any of various devices for arranging (as informational items or the events in the launching of a rocket) into or separating (as amino acids) in a sequence." (Webster's, at 1073; Exhibit 12 to Block Decl.)

[5] As there are multiple definitions for "encode" (and therefore multiple definitions for "encoder"), the Court must identify which of the possible dictionary definitions is most consistent with the use by the inventors. Texas Digital, 308 F.3d at 1203.

The Court must next examine the specification to determine whether this ordinary meaning for "sequence encoder" is consistent with the patent specification. The phrase "sequence encoder" is not used in the specification of the '702 patent[6]. Instead, the '702 patent discloses a time encoder which places formatted data into a sequence of addressable data blocks:

> The transmission system 100 of the present invention also preferably includes ordering means for placing the formatted information into a *sequence* of addressable data blocks. As shown in FIG. 2a, the ordering means in the preferred embodiment includes *time encoder* 114.
>
> * * *
>
> The *sequence* of addressable data blocks which was time encoded and output by *time encoder* 114 is preferably sent to precompression processor 115.

('702 patent, 7:50-54; 8:46-49; emphasis added).[7]

The time encoder is an encoder which places blocks of converted formatted information into a sequence or group of addressable data blocks by assigning relative time markers to data prior to subsequent compression. ('702 patent, 7:57-59; 8:6-9; 8:46-49; Fig. 2a).

From the specification's explicit descriptions of the invention, the invention clearly involved sequencing data blocks through time encoding and using a time

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[6] The fact that "sequence encoder" is not used in the specification, but only appears in the claims, is permissible. All Dental Prodx, LLC v. Advantage Dental Products, Inc., 309 F.3d 774, 779 (Fed. Cir. 2002), citing, Eiselstein v. Frank, 52 F.3d 1035, 1038 (Fed. Cir. 1995) ("However, the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.")

[7] The specification further states that the processing includes "placing the formatted data into a sequence of addressable data blocks by ordering means 114 (step 413c)." ('702 patent, 18:15-19). The time encoder is indicated with reference numeral 114 elsewhere in the patent. Step 413c in Figure 7 is "sequence data."

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encoder prior to subsequent compression to accomplish that task. The only sequence encoder disclosed in the specification is the time encoder -- no other sequence encoder or sequencing scheme is explicitly disclosed or suggested in the specification. The time encoder's function disclosed in the specification is that time encoding of data prior to subsequent compression. ('702 patent, 8:46-48; 18:15-25; Figures 2a and 7). The inventors described numerous benefits and uses of time encoding prior to subsequent compression to the overall operation of the transmission and reception system. For instance, according to the specification, time encoding allows users to move through data in various modes by moving through frame addresses at various rates ('702 patent, 8:22-24). Time encoding makes items and subsets of items retrievable and addressable throughout the transmission system ('702 patent, 8:37-39). Time encoding makes possible realignment of audio and video data after separate audio and video compression ('992 patent, 7:60-64 and 8:9-10). Lastly, time encoding enables subsequent compression of the information to be improved, because data reduction processes may be performed in the time dimension. ('702 patent, 8:39-43). From the specification, it is evident that the invention is limited to time encoding by a time encoder prior to subsequent compression.

The facts of this case are strikingly similar to those of Phillips v. AWH Corp., 2004 U.S. App. LEXIS 6758 (Fed. Cir. April 8, 2004) (Exhibit 14 to Block Decl.). In Phillips, the invention at issue was for vandalism-resistant building modules consisting of modular wall panels. The invention is useful in the field of prison construction because the panels exhibit desirable sound and fire resistance, impact resistance (i.e., against bullets, bombs), and axial and lateral load bearing qualities. Phillips, at *2. The claim term at issue was "baffle" in the phrase "means . . . comprising internal steel baffles extending inwardly from the steel shell walls." Phillips, at *2. The Federal Circuit held that this phrase was not construed as a means-plus-function claim, because the term "baffles" is sufficient structure. Phillips, at *10.

The court then construed "baffles" using ordinary claim construction rules. The ordinary meaning of "baffles" is "something for deflecting, checking, or otherwise regulating flow." Phillips, *10. The court then looked to the specification "'to ascertain the meaning of a claim term as it is used by the inventor in the context of the entirety of his invention.'" Phillips, at *12, quoting, Comark Communications v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998). The court found the specification "rife with references to impact resistance, especially against projectiles, such as bullets and bombs." Phillips, at *13. The specification further explained that steel panels "form the internal baffles at angles for deflecting bullets." Id.

The court therefore found that the inventors only described their invention in the specification as having baffles oriented at angles other than 90 degrees and therefore limited the construction of "baffles" to those which are oriented at angles other than 90 degrees:

> From the specification's explicit descriptions of the invention, we conclude that the patentee regarded his invention as panels providing impact or projectile resistance and that the baffles must be oriented at angles other than 90 degrees. Baffles directed at 90 degrees cannot deflect projectiles as described in the '798 patent, and, in any event, are disclosed in the prior art.

Phillips, at *15.

The court was not persuaded by the dissent-in-part, which argued that the majority improperly focused on the "preferred embodiment," because, in this case, the preferred embodiment is the invention:

> The dissent-in-part argues that we have interpreted the claims erroneously by focusing only on the 'preferred embodiment.' We disagree. Inspection of the patent shows that baffles angled at other than 90 degrees is the only embodiment disclosed in the

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patent; it is the invention. It is impossible to derive anything else from the specification.

Phillips, at *15.

Thus, even though the term "baffles" has an ordinary meaning that includes baffles disposed both at 90 degrees and at angles other then 90 degrees, the court nevertheless limited the construction of this term to angles other than 90 degrees, because the specification made clear that this was the invention:

> It is true that claims with the non-restrictive term 'baffles' were allowed. However, the patent specification is intended to support and inform the claims, and here it makes it unmistakably clear that the invention involves baffles angled at other than 90 degrees. It is in the interests of a sound patent system and inventors, as well as the public, to hold inventors to their disclosures.[8]

Phillips, at *17.

In this case, the ordinary meaning of "sequence encoder" includes a time encoder, but could also include other sequence encoders. But, just as the only baffles disclosed in the specification in the Phillips were disposed at an angle other than 90 degrees, in this case the only sequence encoder disclosed in the '702 patent specification is a time encoder. The description in the '702 patent shows that the inventors intended that the invention be limited to a time encoder using time encoding prior to subsequent compression, because this is the only disclosure in the patent and

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[8] Acacia's original construction of "sequence encoder," set forth in its original discovery responses, was not limited to a time encoder. When Acacia made its original discovery responses, the Phillips case had not been decided by the Federal Circuit and it was not clear that a non-restrictive phrase, such as "sequence encoder," would take on a restrictive construction under the facts presented in this case. After reading the Phillips case, which was decided on April 8, 2004, Acacia determined that it could not support a broader construction and, therefore, on May 4, 2004, Acacia supplemented its proposed construction to limit the construction of "sequence encoder" to the time encoder. (See, Exhibit 15 to Block Decl.).

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the inventors described the many benefits and uses of time encoding prior to subsequent compression:

1. "Time encoding allows realignment of the audio and video information in the compressed data formatting system 117 after separate video and audio compression processing by precompression processor 115 and compressor 116." ('702 patent, 8:60-64).

2. "Realignment of audio and video data, system addressing of particular data bytes, and user addressing of particular portions of items are all made possible through time encoding." ('702 patent, 8:9-12).

3. "Time encoding by time encoder 114 makes items and subsets of items retrievable and addressable throughout the transmission system 100." ('702 patent, 8:37-40).

4. "Time encoding enables subsequent compression of the information to be improved because data reduction processes may be performed in the time dimension." ('702 patent, 8:39-42).

These statements in the specification evidence the inventors' intent to restrict the invention to time encoding by a time encoder prior to subsequent compression.[9] As stated in Phillips, "[i]t is impossible to derive anything else from the specification."[10] Phillips, at *15.

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[9] Because these statements in the specification evidence the inventors' intent to limit the scope of the invention to time encoding by a time encoder, this case differs from other recent cases in which there was no such evidence in the specification. See, e.g., Liebel-Flarsheim Co. v. Mallinckrodt, Inc., 358 F.3d 898, 906 (Fed. Cir. 2004); Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1327 (Fed. Cir. 2002).

[10] The fact that the '702 patent specification describes the "time encoder" as "preferred" does not mean that the claim term "sequence encoder" must be interpreted as being broader than "time encoder." "The usage 'preferred' does not of itself broaden the claims beyond their support in the specification. Wang Laboratories, Inc. v. America Online, Inc., 197 F.3d 1377, 1383 (Fed. Cir. 1999), citing, Great American Transportation Corporation Corp. v. Cryo-Trans, Inc., 93 F.3d 766, 770 (Fed. Cir. 1996) (the teaching in the specification was "not just the preferred embodiment of the invention; it is the only one described."); See also, Toro Co. v. White Consolidated Industries, Inc., 199 F.3d 1295, 1301 (Fed. Cir. 1999) ("The specification shows only a structure whereby the restriction ring is 'part of' the cover, in permanent attachment. This is not simply the preferred embodiment; it is the only

Thus, the phrase "sequence encoder" is construed consistent with the scope of the invention disclosed in the '702 patent specification as a "time encoder, i.e., a device or software which places blocks of converted formatted information into a sequence or group of addressable data blocks by assigning relative time markers to data prior to subsequent compression."

F. "Identification Encoder"

The phrase "identification encoder" is found in claims 1, 5, 6, 17, 19, 27, and 31 of the '702 patent.

As discussed above, the term "encoder" has a well-known meaning to those of skill in the art of electrical engineering, electronics, and computing. An encoder is "a device or system that encodes data." (IEEE Dictionary, at 437; Exhibit 11 to Block Decl.) An encoder "may be implemented in hardware or software." (Dictionary of Computing, 3rd Ed. 1990, at 155; Exhibit 12 to Block Decl.) The term "encode" is also well-known and means: "(1) to express a single character or a message in terms of a code; (2) to produce a unique combination of a group of output signals in response to each of a group of input signals; (3) to apply the rules of a code; and (4) to represent data in symbolic form using a code or a coded character set such that reconversion to the original form is possible." (IEEE Dictionary, at 436-437; Exhibit 11 to Block Decl.)

The term "encoder" is further defined and narrowed by the term "identification," which means "evidence of identity." (Webster's, at 597; Exhibit 12 to Block Decl.) Personalized Media, 161 F.3d at 705.

The ordinary meaning of "identification encoder" is therefore a device or software: (1) capable of expressing a character or message (the identification of an item) in terms of a code; (2) capable of producing a unique combination of a group of output signals in response to each of a group of input signals; (3) capable of applying

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embodiment.")

the rules of a code; or (4) capable of representing data in symbolic form using a code or a coded character set such that reconversion to the original form is possible.

As there are multiple definitions for "encode" (and therefore multiple definitions for "encoder"), the Court must identify which of the possible dictionary definitions is most consistent with the use by the inventors -- if more than one meaning is consistent with the use by the inventors, then the claim term may be construed to encompass all such consistent meanings. Texas Digital, 308 F.3d at 1203.

The specification of the '702 patent is consistent with and reinforces the definition of encoder using the definition of encode -- "to express a single character or a message in terms of a code." The specification defines the "identification encoder" as an encoder which gives [or assigns] a unique identification code to an item. ('702 patent, 6:31-35: "Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item must be . . . given a unique identification code by identification encoder 112."; See also, 6:52-54; 6:57-58; 10:9-11; 18:11-15).[11] Thus, the "identification encoder" expresses a message -- the unique identification code.

Therefore the "identification encoder" is construed as "a device or software capable of expressing the identification of an item in terms of a code."

G. "Transceiver"

The term "transceiver" is found in claims 1, 17, and 27 of the '702 patent. A transceiver is a device that is capable of both transmitting and receiving data.

The term "transceiver" is defined essentially the same way in at least four different dictionaries:

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[11] The specification further defines the identification encoder to optionally log details about the item (program notes) and assign the item a popularity code. ('702 patent, 6:34-39; 10:45-46; 12:4-5). As part of these optional features, the identification encoder may also map item addresses to item names and may operate a program which updates a master item database containing facts regarding items in the compressed data library. ('702 patent, 10:52-58).

1. "A terminal device that can both transmit and receive signals." (Computer Dictionary and Handbook, Sippl and Sippl, 3rd Ed. 1980 at 594) (Exhibit 16 to Block Decl.);

2. "A terminal device that can both transmit and receive signals." (Dictionary of Information Technology, 2nd Ed. 1986, p. 341) (Exhibit 17 to Block Decl.);

3. "*Acronym for* transmitter and receiver. A device that can both transmit and receive signals on a communication medium." (Dictionary of Computing, 3rd Ed. 1990, p. 474) (Exhibit 18 to Block Decl.); and

4. "A device that both transmits and receives data." ("The IEEE Standard Dictionary of Electrical and Electronics Terms, 6th Ed. 1996, p. 1128) (Exhibit 19 to Block Decl.)

The specification of the '702 patent is consistent with and reinforces this definition. The transceiver 201 for the reception system is shown in Figure 6 of the '702 patent. The '702 patent states that the transceiver 201 of the reception system "automatically receives the information from the transmitter 122 as compressed data blocks." ('702 patent, 17:25-27).

Transceivers are also shown in the transmission system in Figure 2b of the '702 patent Figure 6 shows transceivers, which both transmit and receive information (note the arrows both to and from the transceivers). These transceivers are shown in Figure 2b as operating on communication channels, such as ISDN, B-ISDN, LAN [local are network] or MAN [metropolitan area network], and telephone.

One district court has construed the term "transceiver" in a patent claim consistent with the construction offered here by Acacia. In Inline Connection Corp. v. AOL Time Warner, Inc., 302 F. Supp. 2d 307, 324-325 (D. Del. 2004), the court held that the defendants failed to overcome the heavy presumption that the term transceiver should not carry its ordinary meaning. Id. The court therefore construed "transceiver" to mean "a device capable of both sending and receiving information."

Id. The court obtained this ordinary meaning from the Dictionary of Computing (3rd ed. 1991, p. 474) (Exhibit 18 to Block Decl.), cited by Acacia above. Inline Connection, 302 F. Supp. 2d at 325 n 79.

Thus, the term "transceiver" is construed to mean "a device that is capable of both transmitting and receiving data."

H. "Wherein Said Identification Encoder Allows Entry Of A Popularity Code"

The phrase "wherein said identification encoder allows entry of a popularity code" is found in claims 6 and 27 of the '702 patent.

The term "popularity" means: "the quality or state of being popular." (Webster's, at 915; Exhibit 12 to Block Decl.) The term "popular" means: "frequently encountered or widely accepted; commonly liked or approved." (Webster's, at 915; Exhibit 12 to Block Decl.) The term "code" means: "a system symbols (as letters, numbers, or words) used to represent assigned and often secret meanings." (Webster's, at 255; Exhibit 12 to Block Decl.)

Thus, a popularity code is the symbols, letters, or words or combinations thereof used to represent the popularity of a particular item.

This meaning is consistent with and reinforced by the specification of the '702 patent. The '702 patent states that the identification encoder may also allow entry of a popularity code for an item: "The storage encoding process performed by identification encoder 112 also allows entry of a popularity code." ('702 patent, 12:4-5). The '702 patent further states that the popularity code is assigned on the basis on how often the item is expected to be requested for transmission: "The popularity code is preferably assigned on the basis of how often the corresponding item is expected to be requested from the compressed data library 118." ('702 patent, 12:5-8). Further, the popularity code may be updated, to take into account how often an item is actually transmitted: "Once assigned, the popularity code may be dynamically updated, by factoring item usage against system usage." ('702 patent, 12:13-14).

Thus, the phrase "wherein said identification encoder allows entry of a popularity code" is construed as:

"a popularity code is the symbols, letters, or words or combinations thereof used to represent the popularity of a particular item. The identification encoder allows entry of the popularity code."

I. "Temporary Storage Device"

The phrase "temporary storage device" is found in claims 14 and 41 of the '702 patent. A "temporary storage device" is a device into which data may be placed, retained for a limited time, and retrieved.

Claim 14 is dependent from claim 13, which is dependent from claim 1. Claim 13 adds the limitation to claim 1 that the storage device of claim 1 stores at least a portion of a data file. Claim 14 adds the limitation to claim 13 that the storage device is a temporary storage device.

Claim 41 is dependent from claim 39, which is dependent from independent claim 27. Claim 39 adds the limitation to claim 27 that the storage device of claim 27 stores at least a portion of a data file. Claim 41 adds the limitation to claim 39 that the storage device is a temporary storage device.

Thus, the temporary storage device of claims 14 and 41 does not need to store an entire data file -- it may store only a portion of a data file.

The phrase "storage device" means: "a device into which data can be placed, in which they can be retained, and from which they can be retrieved." (IEEE Dictionary, Sixth Edition, 1996, at 1049; Exhibit 19 to Block Decl.) Temporary means: "lasting for a limited time." (Webster's, at 1214; Exhibit 12 to Block Decl.) Thus, a temporary storage device is a device into which data may be placed, retained for a limited time, and retrieved.

This meaning is consistent with and reinforced by the specification of the '702 patent. The '702 patent states that the storage device is used to store the item received by the reception system prior to play back by the user. ('702 patent, 17:33-38 and 18:46-49).

The '702 patent discloses that the storage device may store only a portion of the item received by the reception system. This occurs when the system decompresses other portions of the item for immediate viewing and when the remainder of the item is being received by the reception system:

> Alternatively, the reception systems 200 of the present invention may perform a combination of buffering and non-buffering by buffering some of the requested material and decompressing the remainder of the requested material for immediate viewing as it is distributed by transmission system 100.

('702 patent, 4:66 - 5:7 and 17:38-39; Figure 6).

The '702 patent uses the term "buffering." "Buffering" is simply another term for storing in a temporary storage device. "Buffering" means "the process of using a buffer." (IEEE Dictionary, Fifth Ed., at 135; Exhibit 11 to Block Decl.) A "buffer" is: "a device in which data are stored temporarily, in the course of transmission from one point to another; used to compensate for a difference in the flow of data, or time occurrence of events, when transmitting data from one device to another." (Id.)

Thus, the phrase "temporary storage device" is construed as "a device into which data may be placed, retained for a limited time, and retrieved."

J. "Digital Decompressor" (Claim 1 Of The '702 Patent)

Due to a Patent Office error, claim 1 of the '702 patent, as printed, included the term "digital compressor" as part of the reception system. It is indisputable that this is a minor typographical/clerical error by the Patent Office and that the correct term, as evident by an examination of the '702 patent and its file history, is "digital decompressor." The Patent Office issued a Certificate of Correction on April 15, 2003. (Exhibit 20 to Block Decl.).

Congress recognized that errors will be made in preparing patents and therefore it passed two statutes which address the correction of errors -- 35 U.S.C. § 254 allows for the correction of errors made by the Patent Office and 35 U.S.C. § 255 allows for correction of minor errors made by the applicant. In this case, the inventors utilized Section 254 (Exhibit 21 to Block Decl.) and, on April 15, 2003, obtained a Certificate of Correction from the Patent Office correcting the Patent Office's typographical/clerical error. (Exhibit 20 to Block Decl.).

Pursuant to the language of Sections 254 and 255, the Certificate of Correction is only "effective for causes of action arising after it was issued." See, Southwest Software, Inc. v. Harlequin, Inc., 226 F.3d 1280, 1294 (Fed. Cir. 2000). Thus, "for causes of action that arise before the correction becomes effective, the patent must be considered without the benefit of the certificate of correction." Novo Industries, L.P. v. Micro Molds Corp., 350 F.3d 1348, 1356 (Fed. Cir. 2003). Acacia filed some of the actions now pending before April 15, 2003 and filed some after April 15, 2003. Thus, for the cases Acacia filed before April 15, 2003, the certificate of correction is not effective, but for the cases Acacia filed after April 15, 2003, the certificate of correction is effective and the term in the claim is "digital decompressor."

For the cases which Acacia filed before April 15, 2003, the question then becomes whether the Court has the authority to correct an obvious error in a patent where no certificate of correction has been issued. For minor typographical and clerical errors, the Federal Circuit has held that courts can make these corrections. Novo Industries, 350 F.3d at 1357, citing, Lemelson v. General Mills, Inc., 968 F.2d 1202, 1203 n 3 (Fed. Cir. 1992) ("After the enactment of sections 254 and 255, we have assumed that courts can continue to correct obvious minor typographical and clerical errors in patents.")

For major errors, the court in Novo Industries held that:

> A district court can correct a patent only if (1) the correction is not subject to reasonable debate based on consideration of the

claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.

Novo Industries, 350 F.3d at 1357.[12]

1. The Term "Digital Compressor" Is An Obvious Typographical/Clerical Error by the Patent Office

In this case, the term "digital compressor" is an obvious typographical/clerical error of the type which a court has always been able to correct. There can be no reasonable debate that the correct term is "digital decompressor" and the fact that this is the correct term is evident from the file history of the '702 patent.

In claim 1, the "digital decompressor" is part of the reception system. The invention described in the '702 patent includes systems for transmitting compressed audio and/or video and for receiving the video and decompressing it for playback. Nowhere in the '702 patent is an embodiment described in which a compressor is located in the reception system. This would make no sense, because compressed data is being received at the reception system. There is, however, a digital decompressor disclosed as part of the reception system. ('702 patent, 17:44-52 and Figure 6). Claim 1 further states that the "playback device is in data communication with said digital decompressor."

The inventors filed original claim 33, which issued as claim 1 of the '702 patent, in a preliminary amendment dated February 10, 1999. In claim 33, the term was digital decompressor. (Exhibit 3 at p. 56 to Block Decl.). The examiner

[12] In reaching this holding, the Federal Circuit relied on I.T.S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429, 442, 71 L. Ed. 335, 47 S. Ct. 136 (1926):

> We concur in the finding of the District Judge that the omission of the word "rear" was through a clerical error due to oversight, and that both the counsel for the applicant and the examiner understood that it was contained in claim 8 as well as the others; and we are of opinion that the claim should be construed and have the same effect as if it had been included. This is not in any real sense, a re-making of the claim; but is merely giving to it the meaning which was intended by the applicant and understood by the Examiner.

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understood that this was the term in the claim, because in rejecting claim 33, the examiner specifically pointed to a "decompressor" in the cited prior art to Tindell. (Office Action dated June 22, 1999; Exhibit 4 to Block Decl., at 65).

In response to this Office action, the inventors amended claim 33. They did not amend the "digital decompressor" term and again reproduced the term "digital decompressor" in claim 33. (See, Reply and Amendment Under 37 C.F.R. § 1.111, dated August 6, 1999; Exhibit 5 at p. 69 to Block Decl.). In rejecting claim 33, the Examiner again specifically pointed to a "digital decompressor" in the cited prior art to Walter. (Office Action dated January 19, 2000; Exhibit 8 to Block Decl., at p. 86).

On March 23, 2000, the inventors made another amendment to claim 33 (of different portion than the digital decompressor) and again they reproduced the term "digital decompressor" in claim 33. (See, Reply and Amendment Under 37 C.F.R. § 1.111, dated March 23, 2000; Exhibit 9 at p. 90 to Block Decl.). There was no further discussion or mention of claim 33 or the "digital decompressor" term.

When the Patent Office printed the '702 patent, the Patent Office made a typographical/clerical error and changed the term in claim 33 from "digital decompressor" to "digital compressor." This was the Patent Office's error, not the inventor's error. There can be no reasonable debate from the claim language (which refers to the digital decompressor) or the specification (which discloses only a decompressor in the reception system) that the correct term is "digital decompressor." The file history further shows that the inventors intended the term to be "digital decompressor" and that the examiner had examined a claim having "digital decompressor." Claim 1 of the '702 patent, in the "playback device" element even states that the playback device is in data communication with "said digital decompressor," obviously referring to the digital decompressor, which was to be identified above. There is thus no doubt that this was a typographical/clerical error by the Patent Office, which the Court should correct on its own. Novo Industries, 350 F.3d at 1357

Therefore, in the cases file by Acacia before April 15, 2003, the Court should construe the term to be "digital decompressor," to give the claim the meaning intended by the inventors and understood by the examiner. For cases filed by Acacia after April 15, 2003, the Certificate of Correction issued by the Patent Office applies and the correct term is "digital decompressor."

A digital decompressor is a device or software that decompresses previously compressed digital data.

K. "Ordering Means, Coupled To The Conversion Means, For Placing The Formatted Data Into A Sequence Of Addressable Data Blocks" ('992 Patent -- Claim 1).

The phrase "ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks" is found in claim 1 of the '992 patent. (Exhibit 2 to Block Decl.). This phrase includes the terms "means for" and therefore the phrase is presumed to be construed as a means-plus-function claim element pursuant to 35 U.S.C. § 112, ¶ 6. This presumption is not rebutted and this claim phrase is construed as a means-plus-function element, by first defining the claimed function and then determining the structure disclosed in the specification for performing this function.

1. The Claimed Function -- Placing The Formatted Data Into A Sequence Of Addressable Data Blocks

The function of the ordering means is stated in the claim phrase itself -- "placing the formatted data into a sequence of addressable data blocks."

The term "placing" means "to put in a particular state." (Webster's, at 897; Exhibit 12 to Block Decl.)

The phrase "formatted data" refers to the data output from the conversion means. According to claim 1 of the '992 patent, the conversion means places the received information "into a predetermined format as formatted data."

The construction of the phrase "sequence of addressable data blocks" is discussed in detail in Acacia's prior Markman Brief and Opposition. A sequence of addressable data blocks is "a series of digital data bytes which represent frames of video and/or samples of audio data wherein relative time markers assigned to the audio and/or video data makes the frames of video data and/or samples of audio data addressable within a particular item of information."

2. The '702 Patent Discloses That The Ordering Means Is A Time Encoder

The specification of the '702 patent discloses that the ordering means is a time encoder and discloses that the time encoder performs the function of placing the formatted data from the conversion means into a sequence of addressable data blocks:

> The transmission system 100 of the present invention also preferably includes ordering means for placing the formatted information into a sequence of addressable data blocks. As shown in FIG. 2a, the ordering means in the preferred embodiment includes time encoder 114. After the retrieved information is converted and formatted by the converter 113, the information may be time encoded by the time encoder 114. Time encoder 114 places the blocks of converted formatted information from converter 113 into a group of addressable blocks. The preferred addressing scheme employs time encoding.
>
> * * *
>
> The sequence of addressable data blocks which was time encoded and output by time encoder 114 is preferably sent to precompression processor 115.

('992 patent, 7:59-8:2 and 8:59-62).

The '992 patent further explains that "time encoding by time encoder 114 is achieved by assigning relative time markers to the audio and video data as it passes from the converter 113 to the precompression processor 115." ('992 patent, 8:16-19).

As discussed above in Section IV. B., a time encoder is a device or software which places blocks of converted formatted information into a sequence or group of addressable data blocks by assigning relative time markers to data prior to subsequent compression. ('992 patent, 7:59 - 8:2 and 8:16-19).

Thus, the "ordering means" is construed to mean "a time encoder, i.e., a device or software which places blocks of converted formatted information into a sequence or group of addressable data blocks by assigning relative time markers to data prior to subsequent compression and all equivalents thereof."

3. The Construction Of "Coupled To"

The "ordering means" phrase also uses the phrase "coupled to" to state that the ordering means is coupled to the conversion means. Claim 1 of the '992 patent also states that the conversion means is coupled to the identification encoding means, the compression means is coupled to the ordering means, the compressed data storing means is coupled to the compression means, and the transmitter means is coupled to the compressed data storing means.

The term "coupling" in the context of data transmission means: "the association of two or more circuits or systems in such a way that power or signal information may be transferred from one to another." (IEEE Dictionary, 5th Ed. at 277; Exhibit 11 to Block Decl.) The phrase "coupled to" therefore means that two or more circuits or systems are associated in such a way that power or signal information may be transferred from one to another.

This meaning is consistent with and reinforced by the specification of the '992 patent. The '992 patent specification shows and describes that information/data is transferred between the various elements of the transmission system. For instance, the conversion means being coupled to the identification encoding means is shown in

Figure 2a and at 6:65-69. The ordering means being coupled to the conversion means is shown in Figure 2a and described at 7:64-66 and 8:16-19. The compression means being coupled to the ordering means is shown in Figure 2a and described at 8:59-62 and 9:41-42. The compressed data storing means being coupled to the compression means is shown in Figure 2a and described at 10:23-26. The transmitter means being coupled to the compressed data storing means is shown in Figures 2a and 2b and 15:55 - 16:3.

Thus, the term "coupled to" is construed to mean "two or more circuits or systems are associated in such a way that power or signal information may be transferred from one to another"

V. CONCLUSION

For the foregoing reasons and authorities, Acacia respectfully requests that its proposed claim constructions be adopted by this Court.

DATED: May 7, 2004

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PROOF OF SERVICE

I, Sylvia A. Berson, declare:

I am a citizen of the United States and employed in Los Angeles County, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 601 South Figueroa Street, Suite 3300, Los Angeles, California 90017.

On **May 7, 2004**, I served a copy of the within document(s) described as **PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S CLAIM CONSTRUCTION BRIEF RE: CLAIM TERMS IN THE '702 PATENT** by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document(s) listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on attached Service List.

The above-described document was also transmitted to the parties indicated below, by United States Mail only.

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I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of mail with the United States Postal Service; pursuant to that practice, envelopes placed for collection at designated locations during designated hours are deposited with the United States Postal Service with first class postage thereon fully prepaid that same day in the ordinary course of business; and, I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on **May 7, 2004**, at Los Angeles, California.

/s/
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